



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/571,012

03/08/2006

Frank Cuttitta

4239-82094-06

4600

36218 7590 09/23/2010  
KLARQUIST SPARKMAN, LLP (OTT-NIH)  
121 S.W. SALMON STREET  
SUITE #1600  
PORTLAND, OR 97204-2988

EXAMINER

PAGONAKIS, ANNA

ART UNIT

PAPER NUMBER

1628

NOTIFICATION DATE

DELIVERY MODE

09/23/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tanya.harding@klarquist.com  
docketing@klarquist.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/571,012	<b>Applicant(s)</b> CUTTITTA ET AL.	
	<b>Examiner</b> ANNA PAGONAKIS	<b>Art Unit</b> 1628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 80-81 and 90-97 is/are pending in the application.
- 4a) Of the above claim(s) 91-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80,81,90 and 94-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1 sheet:9/10/2010</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1628

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's payment and submission filed 9/10/2010, has been received and entered into the present application. Accordingly, prosecution has been reopened.

Applicant is reminded of the response to the election of specie requirement made on 11/18/2009 wherein the specie of cellular proliferative disorders was elected. Given that election of specie, claims which are drawn diseases which are not cellular proliferative disorders have been withdrawn from examination.

Applicant's arguments filed 9/10/2010 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

### **Status of Claims**

Claims 80-81 and 90-97 are pending.

Claims 91-93 are withdrawn.

Claims 80-81, 90 and 94-97 are currently under examination and the subject matter of the present Office Action.

### **New rejection:**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1628

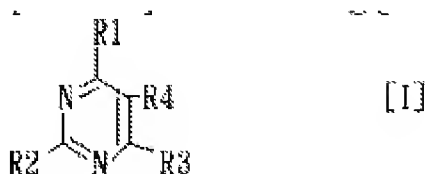
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80-81, 90 and 94-97 are rejected under 35 U.S.C. 102(b) as being anticipated by JP

10212235 (original document and translation are attached).

JP 10212235 teaches a compound of formula (I) wherein the compound is that of instant claim 80 (paragraph [0064] of translation):



化合物番号	R1	R2	R3	R4
105	C1	-NH2	-NHCH2CH2OH	H

Further, it is taught that the compounds of formula (I) is effective for the treatment of tumors, for example, stomach cancer, such as malignant tumor, a benign tumor, and a precancerous change, lung cancer, hepatoma, a pancreatic cancer, colon cancer, a malignant lymphoma, leukemia, a breast carcinoma, melanoma, renal cancer, brain tumor, peritoneal tumor, spinal cord tumor, hypophyseal tumor, thyroid tumor, laryngeal cancer etc. (paragraph [0035] of translation).

Though JP 10212235 is silent as to the effect of the elected compound to inhibit an activity of a gastrin releasing peptide (GRP), the administration of the claimed compound to patients suffering from cellular proliferative disorders is expected to necessarily have the claimed effect of inhibiting an activity of GRP, whether recognized by the author or not. Products of identical chemical composition cannot

Art Unit: 1628

exert mutually exclusive properties when administered under the same circumstance or, in the present case, the same host. Please reference MPEP 2112.

Moreover, the very teaching of administering the identical compound to the same patient populations (i.e. patients suffering from cellular proliferative disorders) necessarily means that the claimed inhibition of GRP is necessarily present, whether recognized by the author or not. As stated supra, products of identical composition cannot exert mutually exclusive properties. Please reference MPEP 2112 and *Ex parte Novitski*, 26 USPQ 1389 (Bd. Pat. App. and Inter 1993).

### **Conclusion**

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 7am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/571,012

Page 5

Art Unit: 1628

AP

/Brandon J Fetterolf/

Supervisory Patent Examiner, Art Unit 1628